

Appl. No. 10/735,950
Response dated February 14, 2006
Reply to Office Action of 11/21/2005

application in response to the Office's requirement of restriction. Group III as outlined in the Office Action dated 11/21/2005 includes claims 18-29.

Traverse

Applicant respectfully traverses the restriction of the instant applicant into groups I, II, III, IV, and V and requests reconsideration of the restriction requirement in light of the following remarks.

In the Office Action dated 11/21/05, the Office stated that:

"Inventions I through V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are **distinct** (emphasis added) from each other if they are shown to be separately usable. In the instant case, inventions I through V have separate utility such as the independent details of the apparatus may be separately usable and the manner of operating the apparatus does not specifically need to be provided by the method of configuring and arranging the apparatus.

Because these inventions are **distinct** (emphasis added) for the reasons given above and the search required for individual inventions of Group I-V is not required for the remainder, restriction for examination purposes as indicated is proper. Although the listed classifications are the same, there is still a burdensome search as the subcombination and methods are not specifically limited to be only usable with all other subcombinations." Office Action, 11/21/05, page 2-3.

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Respectfully, Applicant contends that:

1. the Office has not shown "separate utility" as required by MPEP 806.05(d) in order to support the assertion that the subcombinations are distinct; and

2. even if the Office demonstrates "separate utility," the Office has failed to explain why there would be a "serious burden" on the Office if restriction is not required, such explanation is required of the Office by MPEP 808.02 in order to support restriction.

Respectfully, the Office has not made out a proper *prima facie* case for restricting the claims in the instant application. Specifically, to establish a *prima facie* case for restriction the Office needs to:

- (1) provide reasons why the inventions as claimed are distinct, and
- (2) MPEP 808.02 – establish the burden on the Office by explaining why the distinct inventions must be restricted on the basis of:
 - (a) separate classification;
 - (b) separate status in the art, or
 - (c) a different field of search.

Lack of Distinctness Between Subcombinations

Applicant maintains that the subcombinations are not distinct since they are usable together (subcombinations overlap in scope). MPEP 806.05(d), page

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800-45, column 2, paragraph 5. "If they are not distinct, restriction is never proper." MPEP 806.05, page 800-44, column 1, paragraph 1.

Respectfully, Applicant points out that the Office has failed to show how the subcombinations are separately usable. According to MPEP 806.05(d):

"Two or more claimed subcombinations disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants." MPEP 806.05(d), page 800-45, column 2, paragraph 5.

MPEP 806.05(d) requires the Office to specifically identify the appropriate group number or to identify the subcombination (see Examiner Note 2, page 800-46) and then to suggest utility other than with the other subcombination(s) (see Examiner Note 3, page 800-46). "The Examiner must show by way of example, that one of the subcombinations has utility other than in the disclosed combination." MPEP 806.05(d), page 800-46, column 1, paragraph 3.

Respectfully, in the instant application, the Office has not fulfilled the requirements necessary to support restriction. Specifically, the Office has not indicated which of the five groups of claims has separate utility nor has the Office suggested a utility apart from the other subcombinations. No example of separate utility apart from the disclosed combination, found in the application,

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has been proffered by the Office as is required by MPEP 806.05(d) page 800-46, column 1, paragraph 3.

Respectfully, Applicant contends that restriction in the instant application is improper since the Office has failed to demonstrate that the asserted subcombinations are distinct. The Office has failed to provide the required specific examples of "utility other than in the disclosed combination." MPEP 806.05(d) page 800-46, column 1, paragraph 3.

Lack of Serious Burden on the Office

Applicant maintains that the subcombinations, as defined by the Office, are related and not distinct, therefore restriction under 35 U.S.C. 121 is never proper. MPEP 808.02, page 800-51, column 2, paragraph 5. Respectfully, Applicant maintains that the Office has failed to carry its burden under MPEP 808.02, which requires the Office to demonstrate that a serious burden is presented if the restriction is not made.

In the instant case all subcombinations are in the **same** classification. Therefore MPEP 808.02 (A) is not grounds to support restriction.

The office has not shown that the asserted subcombinations have achieved separate status in the art. In order to show separate status in the art, the Office can cite patents to demonstrate recognition of separate inventive effort by

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inventors or that a separate field of search is required. MPEP 808.02(B).

Therefore MPEP 808.02 (B) is not grounds to support restriction.

Respectfully, the Office has merely stated that "there is still a burdensome search" even though the asserted subcombinations have the same classification. The office has not demonstrated that a different field of search is required. On the contrary Applicant points out that the following terms or functional limitations: **"all terrain vehicle"** and **"all terrain vehicle transmission shaft"** and **"coupling to all terrain vehicle transmission shaft"** appear in all of the asserted claims groups. Such occurrence of common terms and functional limitations does not complicate the search, but in fact simplifies the search. Therefore MPEP 808.02 (C) is not grounds to support restriction.

Requirement of Restriction is Discretionary for the Office

Applicant wishes to point out that MPEP 803 uses permissive language with regard to restriction, i.e.:

"If the search and examination of all the claims in an application can be made without **serious** burden (emphasis added), the examiner must examine them on the merits, even though they include claims to independent or distinct inventions." MPEP 803, page 800-4, column 1, paragraph 2.

In the instant case, the present restriction places a large financial burden on the Applicant since four divisional patent applications would be required to

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accomplish examination of all 43 claims. Applicant is a small entity with finite resources and respectfully states that the instant restriction requirement jeopardizes Applicant's ability to obtain a proper examination of the instant patent application.

The additional four divisional patent applications that could result from the instant restriction will exacerbate the already large workload at the Office, lengthening the time required to complete examination of the potential five patent applications. Applicant contends that this result does not further either the interests of the Applicant, the Office, or the public.

On the contrary, all interests are served by one efficient examination of all claims presented in the instant application. As Applicant pointed out above, the following terms or functional limitations: **"all terrain vehicle"** and **"all terrain vehicle transmission shaft"** and **"coupling to all terrain vehicle transmission shaft"** appear in *all* of the asserted claim groups. Such occurrence of common terms and functional limitations does not complicate the search, but in fact simplifies the search.

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CONCLUSION

Applicant has provided the election of claims as requested by the Office and has traversed the restriction requirement. Applicant has demonstrated that the subcombinations, asserted by the Office, are not distinct and that there is no **serious** burden posed by the examination of claims 1-43 as presented in the instant application. As such, the Office has failed to make out the required *prima facie* case needed to support restriction. Applicant respectfully requests reconsideration and removal of the restriction requirement and examination of all claims presented.

Respectfully submitted,
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February 14, 2006
Date

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(Typed or printed name of person transmitting paper or fee)

Mark S. Peloquin, Esq. February 14, 2006
(Signature of person transmitting paper or fee) Date